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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,626	03/09/2001	Leslie Lobel	62259/JPW/SHS	5559

7590

08/08/2003

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EXAMINER

JIANG, DONG

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,626

Applicant(s)

LOBEL ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,7,16,18,24-26,32-42 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,2,4,7,16,18,24-26,32-42 and 44-47 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Applicant's preliminary amendment in paper No. 5, filed on 01 March 2001 is acknowledged and entered. Following the amendment, claims 3, 5-6, 8-15, 17, 19-23, 27-31, 43, 48 and 49 are canceled, and claims 4, 7, 16 and 26 are amended.

Currently, claims 1, 2, 4, 7, 16, 18, 24-26, 32-42 and 44-47 are pending.

#### Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 4, 7, 16, 18, 24-26, drawn to a nucleic acid, a vector containing same, a host cell thereof, a method of recombinantly producing the encoded polypeptide, and the soluble polypeptide, classified in class 435, subclass 69.7.
- II. Claims 32 and 33, drawn to a method of identifying an antibody, and a method of obtaining a composition thereof, classified in class 435, subclass 7.1.
- III. Claims 34 and 36, drawn to a method of preventing or terminating a pregnancy using an antibody, classified in class 424, subclass 139.1.
- IV. Claims 35 and 37, drawn to a method of preventing or terminating a pregnancy using the polypeptide, classified in class 514, subclass 2.
- V. Claims 38, 39 and 41, drawn to a method of stimulating antibody production or treating/preventing cancer by administering the polypeptide, classified in class 514, subclass 2.
- VI. Claims 40 and 42, drawn to a method of treating/preventing cancer by administering an antibody, classified in class 424, subclass 139.1.
- VII. Claim 44, drawn to a method of decreasing androgen by administering the polypeptide, classified in class 514, subclass 2.
- VIII. Claim 45, drawn to a method of decreasing androgen by administering an antibody, classified in class 424, subclass 139.1.

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IX. Claims 46 and 47, drawn to a method of preventing or treating ovarian hyperstimulatory syndrome by administering an antibody, classified in class 424, subclass 139.1.

The inventions are distinct, each from the other because:

Invention I is distinct from and unrelated to Inventions III, VI, VIII and IX, wherein the polypeptide of Invention I is neither made by nor used in the methods of Inventions II, III, VI, VIII and IX, and wherein each does not require the other.

The soluble polypeptide of Invention I is related to Inventions II, IV, V and VII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed may be used for ligand purification.

Inventions II-IX are drawn to independent methods, wherein each of the methods has different process steps, different active agents, subjects with different pathological conditions, different starting and ending points, and is for a different purpose, such that they require separate searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matters, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

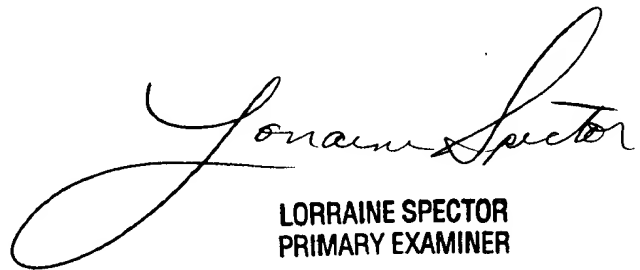
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**Advisory Information**

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



LORRAINE SPECTOR  
PRIMARY EXAMINER

DJ  
8/1/03